

REMARKS

Claims 1, 3, 4, 5, 8, 10, 11, 12, 15, 17, 18, and 19 have been amended. Claims 1-21 remain pending in the application. Reconsideration is respectfully requested in view of the following remarks.

Section 102(b) and 103(a) Rejections:

Prior to appeal, claims 1-5, 8-12 and 15-19 stood rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Billington et al (U.S. Patent 7,103,760) (hereinafter Billington), claims 6, 13 and 20 stood rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Billington in view of Pooni et al. (U.S. Publication 2004/0064461) (hereinafter Pooni), and claims 7, 14 and 21 stood rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Billington in view of Hochmuth et al. (U.S. Publication 2003/0056063) (hereinafter Hochmuth).

In its Decision on Appeal as modified by its Decision on Request for Rehearing (hereinafter DRR), the Board of Patent Appeals and Interferences (hereinafter Board) affirmed these rejections on a theory not previously raised during prosecution. Specifically, the Board raised a new ground of rejection in the Decision on Request for Rehearing in which it “rel[ied] upon the communication between Billington’s devices depicted in Figure 11 to infer sufficient functionality for them to be *capable of* or *configured to* perform the functions recited in Appellants’ claim[] 1.” DRR at 6.

To arrive at this conclusion, the Board correctly noted that the claim limitations “service is configured to execute an application” and “stateless client is configured to enable the user to access the application” as not requiring the recited devices to actually perform the recited functions, but only be capable of performing these functions. DRR at 3. From this, the Board erroneously concluded that “[t]hese recitations are therefore statements of intended use, which are fully met by an anticipating prior art structure that is capable of performing those intended uses.” *Id.* (emphasis).

Applicants respectfully traverse the Board’s conclusion. Although the Board cites various authorities for the proposition that a statement of intended use carries no patentable weight in a claim, the Board cites no authority for the proposition that “configured to” language in the body of a claim is a statement of intended use. Given the considerable consequences of such a rule for many issued patents, one would expect that a Federal Circuit decision would clearly articulate it. However, Applicants are aware of no case law that supports this contention.

The Board’s stance with respect to “configured to” limitations essentially reads these limitations out of the claim, and allows the Board to conclude that so long as a prior art structure is at least capable of performing these features, it anticipates, even if it makes no mention of the feature whatsoever. Applicants note that the Board does not attempt to actually find these limitations in the prior art. In fact, its stance that these limitations are not in fact limiting is tantamount to an admission that these limitations are not actually taught by the prior art.

Nevertheless, in the interests of obtaining a patent without further delay, Applicants have amended the independent claims to clarify that the recited functions do in fact occur when the apparatus is in operation. Thus, for example, claim 1 recites “a server that, during operation, executes an application,” “a mass storage device . . . [that] during operation, . . . is accessed by said user via said server,” and that “during operation, said server stores data to said mass storage device via said stateless client in response to said user’s interaction with said application.”

Applicants note that for the reasons previously set forth during the appeal, Billington does not actually disclose the functional aspects noted above. That is, Billington does not disclose a server, stateless client, and mass storage device arranged as recited in claim 1, where these elements operate to implement the particular pattern of mass storage device access that is recited in claim 1 under the conditions recited in claim 1.

As amended, claim 1 positively recites numerous features as actually being performed. Correspondingly, according to the Board’s logic in its Decision on Request for Rehearing, these features are not merely statements of intended use, but affirmative limitations on the configuration of the recited structure. As such, the ordinary requirements of anticipation apply. That is, “the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008).

Thus, the question is not whether Billington might somehow be capable of fulfilling some intended use included in claim 1. Rather, to anticipate, Billington must actually disclose, either explicitly or inherently, all of the features of claim 1 arranged in the manner recited. As noted above, Billington plainly does not disclose that a user accesses a locally-coupled storage device by interacting with an application executing on a server, much less that data is stored by the server to the mass storage device via the stateless client in response to the user’s interaction with the application.

Applicants submit that for at least these reasons, Billington fails to anticipate amended claim 1. Similar arguments apply to independent claims 8 and 15, which recite features similar to those of claim 1. Moreover, Applicants submit that the remaining cited references fail to remedy Billington’s omissions. Accordingly, Applicants submit that the rejections of independent claims 1, 8, and 15 are unsupported.

The rejections of various dependent claims are further unsupported for additional reasons. For example, claims 4 and 5 have been amended to recite additional features, support for which may be found throughout the specification (e.g., at paragraphs [0046] and [0071]). However, because the rejections of the independent claims have been shown to be unsupported, further discussion of the dependent claims is unnecessary at this time.

CONCLUSION

Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-76100/RCK.

Respectfully submitted,

/Robert C. Kowert/
Robert C. Kowert, Reg. #39,255
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

Date: May 10, 2010